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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,362	02/02/2001	Donald W. Taylor	DE007DT-1	1840

7590 06/27/2006

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EXAMINER

NUTTER, NATHAN M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/776,362

Applicant(s)

TAYLOR ET AL.

Examiner

Nathan M. Nutter

Art Unit

1711

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 6-8, 10, 11, 13-18, 21-28 and 30-39 is/are pending in the application.
- 4a) Of the above claim(s) 3, 6-8, 10, 11, 14, 18, 21-26, 30, 31, 33, 34 and 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 4, 13, 15-17, 27, 28, 32, 35 and 37-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 2, 4, 6, 8, 13, 15-17, 27, 28, 32, 35, and 37-39, and the species of EPDM, in the reply filed on 27 April 2006 is acknowledged. The traversal is on the ground(s) that "there is no undue burden upon the Patent Office to continue to examine the pending claims." This is not found persuasive because of the multitude of concepts as recited and claimed. further, it is noted that since applicants have elected EPDM, claims 6 and 8 will not be included for examination, as not being drawn to the elected species. Only claims 2, 4, 13, 15-17, 27, 28, 32, 35, 38 and 39 will be examined herewith.

The requirement is still deemed proper and is therefore made FINAL.

Specification

The disclosure is objected to because of the following informalities: the spelling of the term "fibrous" is incorrect throughout the Specification and claims. The term "fibrous" does not appear in any dictionary at the disposal of the Examiner and has never been encountered by this Examiner before in clear, concisely written English.

Appropriate correction is required.

Claim Interpretations

The combination of the several ingredients of the formulation, due to the number of required constituents, necessarily would not be found within the confines of a single reference. Only the passivating agent, the "expansion agent" and the curing agent are disclosed and recited as having particular functions. The passivating agents, as

Art Unit: 1711

disclosed, have other uses, such as for thickening compositions, and are also known fillers. No specific function is disclosed for bitumin, though it may be assumed to be as an adhesive or binding agent since the composition is intended to be so. As such, the rejections are being made keeping in mind that inclusion of constituents, as recited, are for their art-recognized functions.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2, 4, 13, 15-17, 27, 28, 32, 35, 38 and 39 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/375,555. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application includes each of the constituents as recited and claimed herein.

Art Unit: 1711

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4, 13, 15-17, 27, 28, 32, 35, 38 and 39 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Saitoh et al (US 5,695,867), newly cited.

The reference to Saitoh et al shows the manufacture of a polymer blend composite material, as recited herein, that may comprise for the damping layer a blend of EPDM and a fluorine containing rubber, at column 5 (lines 6-27), a vulcanizing agent, at column 5 (lines 37-42) and the paragraph bridging column 5 to column 6, asphalt (bitumin), at column 7 (lines 17-28), fibrous fillers at column 8 (lines 8-19), talc, clay or other silicates, including calcium silicate, at the paragraph bridging column 7 to column 8, and foaming agents at column 8 (lines 28-35), including those constituents as recited

Art Unit: 1711

and claimed herein. The damping layer is taught to be adjacent other layers, as herein claimed.

While the instant claims recite a "passivating agent," the reference teaches those as disclosed in the Specification, as useful for filler materials. The disclosed use is not deemed to negate patentability since the presence thereof would have the same effect as herein claimed, regardless of characterization by applicants. Otherwise, the constituents employed by the reference are essentially identical to those recited herein. as such, the instant claims are deemed to be at least obvious, if not anticipated, by the teachings of the reference.

Claims 2, 4, 13, 15-17, 27, 28, 32, 35, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saitoh et al (US 5,695,867), cited and for the reasons as set out above, taken with Kitamura et al (US 5,334,447), Grossman et al (US 4,599,370) and Fuller (US 6,416,834), all newly cited.

The primary reference to Saitoh et al teaches essentially what is recited herein.

The reference to Kitamura et al shows a combination of a fluorine rubber, EPDM, a vulcanizing agent and a foaming agent at column 2 (lines 36-56). The reference teaches the inclusion of silicates at column 3 (lines 12 et seq.). Further, note column 3 (lines 48-58) for the vulcanizing agent, the paragraph bridging column 3 to column 4 for the foaming agent. Use of additional additives, which would include the bitumin recited herein for its art-recognized use, as shown by Saitoh et al.

The patent to Grossman et al shows the conventionality of using either an EPDM elastomer or a fluororubber with bitumen, reinforcing agents and silicates, as recited herein. Note column 3 (lines 47-62) and column 4 (lines 9-25).

The reference to Fuller teaches the conventionality of the use of reinforcing braiding at column 7 (lines 17-24) for EPDM or fluoroelastomers backing, as herein claimed.

The references teach the conventionality of each of the constituents, as recited and herein claimed. Taken together the references are deemed to render obvious the instant claims since all constituents are shown as used in their art-recognized faculties.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1711

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Nathan M. Nutter
Primary Examiner
Art Unit 1711

nmn

22 June 2006